

ESTTA Tracking number: **ESTTA384368**

Filing date: **12/17/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	El Pollo Loco, Inc.
Granted to Date of previous extension	12/29/2010
Address	3535 Harbor Blvd.Suite 100 Costa Mesa, CA 92626 UNITED STATES

Attorney information	Michael A. Rule Pepper Hamilton, LLP 4 Park Plaza Suite 1200 Irvine, CA 92614-5955 UNITED STATES rulem@pepperlaw.com, murrays@pepperlaw.com, chenj@pepperlaw.com Phone:949-567-3507
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Applicant Information

Application No	77950131	Publication date	08/31/2010
Opposition Filing Date	12/17/2010	Opposition Period Ends	12/29/2010
Applicants	Rembao, Oscar 4168 w. granite dells ct. tucson, AZ 84745 UNITED STATES Rembao, Sonia 4168 w. granite dells tucson, AZ 85745 UNITED STATES		

Goods/Services Affected by Opposition

Class 043.


All goods and services in the class are opposed, namely: Carry-out restaurants; Fast-food restaurants; Restaurant; Take-out restaurant services

Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3162229	Application Date	10/13/2005
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Registration Date	10/24/2006	Foreign Priority Date	NONE
Word Mark	EL POLLO LOCO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2000/01/01 First Use In Commerce: 2000/01/01 Franchising and business consulting services relating to the establishment and/or operation of restaurants		

U.S. Registration No.	1237518	Application Date	03/23/1981
Registration Date	05/10/1983	Foreign Priority Date	NONE
Word Mark	EL POLLO LOCO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 1980/12/06 First Use In Commerce: 1980/12/06 Prepared Chicken With and Without a Batter Coating for Consumption On or Off the Premises Class 042. First use: First Use: 1980/12/06 First Use In Commerce: 1980/12/06 Restaurant Services		

U.S. Registration No.	3262641	Application Date	07/21/2005
Registration Date	07/10/2007	Foreign Priority Date	NONE
Word Mark	EL POLLO LOCO		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 029. First use: First Use: 2005/07/05 First Use In Commerce: 2005/07/05 PREPARED ENTREES CONSISTING PRIMARILY OF MARINATED CHICKEN Class 030. First use: First Use: 2005/07/05 First Use In Commerce: 2005/07/05 PREPARED ENTREES CONSISTING OF RICE AND BEANS Class 043. First use: First Use: 2005/07/05 First Use In Commerce: 2005/07/05 Restaurant services

U.S. Registration No.	2934591	Application Date	03/15/2004
Registration Date	03/22/2005	Foreign Priority Date	NONE

Word Mark	EL POLLO LOCO
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 029. First use: First Use: 2000/03/00 First Use In Commerce: 2000/03/00 Prepared citrus-marinated, flame-grilled chicken for consumption on or off the premises Class 043. First use: First Use: 2000/03/00 First Use In Commerce: 2000/03/00 Restaurant services by restaurant chain known for its service of citrus-marinated, flame-grilled chicken and other Mexican dishes
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U.S. Registration No.	3262640	Application Date	07/21/2005
Registration Date	07/10/2007	Foreign Priority Date	NONE


Word Mark	EL POLLO LOCO FLAME-GRILLED MEXICAN CHICKEN
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 029. First use: First Use: 2005/07/05 First Use In Commerce: 2005/07/05 Prepared entrees consisting primarily of marinated chicken Class 030. First use: First Use: 2005/07/05 First Use In Commerce: 2005/07/05 Prepared entrees consisting of rice and beans Class 043. First use: First Use: 2005/07/05 First Use In Commerce: 2005/07/05 Restaurant services
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U.S. Registration No.	3288881	Application Date	10/13/2005
Registration Date	09/04/2007	Foreign Priority Date	NONE
Word Mark	EL POLLO LOCO FLAME-GRILLED MEXICAN CHICKEN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2005/07/05 First Use In Commerce: 2005/07/05 Franchise services, namely, offering technical and business management assistance in the establishment and operation of restaurants		

U.S. Registration No.	3331273	Application Date	07/21/2005
Registration Date	11/06/2007	Foreign Priority Date	NONE
Word Mark	EL POLLO LOCO FLAME-GRILLED MEXICAN CHICKEN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 2005/10/13 First Use In Commerce: 2005/10/13 Prepared entrees consisting primarily of marinated chicken Class 030. First use: First Use: 2005/10/13 First Use In Commerce: 2005/10/13 Prepared entrees consisting of rice and beans		

	Class 043. First use: First Use: 2005/10/13 First Use In Commerce: 2005/10/13 Restaurant services
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U.S. Registration No.	3345387	Application Date	07/21/2005
Registration Date	11/27/2007	Foreign Priority Date	NONE
Word Mark	EL POLLO LOCO FLAME-GRILLED MEXICAN CHICKEN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 2005/10/13 First Use In Commerce: 2005/10/13 Prepared entrees consisting primarily of marinated chicken Class 030. First use: First Use: 2005/10/13 First Use In Commerce: 2005/10/13 Prepared entrees consisting of rice and pinto beans Class 043. First use: First Use: 2005/10/13 First Use In Commerce: 2005/10/13 Restaurant services		

U.S. Registration No.	3320540	Application Date	10/13/2005
Registration Date	10/23/2007	Foreign Priority Date	NONE
Word Mark	EL POLLO LOCO FLAME-GRILLED MEXICAN CHICKEN		
Design Mark			
Description of Mark	The mark consists of a chicken's head above the stylized wording EL POLLO LOCO with flames underneath and the wording FLAME-GRILLED MEXICAN CHICKEN below the flames in a rectangular shaded box. The entire mark is encompassed in a rectangle with a curved top side.		
Goods/Services	Class 035. First use: First Use: 2005/10/13 First Use In Commerce: 2005/10/13 Franchise services, namely, offering technical and business management assistance in the establishment and operation of restaurants		

Attachments	78732922#TMSN.jpeg (1 page)(bytes) 78675568#TMSN.jpeg (1 page)(bytes) 76582035#TMSN.gif (1 page)(bytes) 78675529#TMSN.jpeg (1 page)(bytes) 78732496#TMSN.jpeg (1 page)(bytes) 78675609#TMSN.jpeg (1 page)(bytes) 78675634#TMSN.jpeg (1 page)(bytes) 78732574#TMSN.jpeg (1 page)(bytes) EL POLLO LUCKY opposition executed.pdf (10 pages)(112187 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/Michael A. Rule/
Name	Michael A. Rule
Date	12/17/2010

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

EL POLLO LOCO, INC.

Opposer

Opposition No.



Mark: EL POLLO LUCKY
GRILLED CHICKEN YOU CAN BET ON

v.

Application Serial No. 77/950,131

OSCAR REMBAO AND SONIA REMBAO,
Individuals.

Published in *Official Gazette*: August 31, 2010

Filed: March 4, 2010

Applicant

NOTICE OF OPPOSITION

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Sir/Madam:

El Pollo Loco, Inc., a Delaware corporation with offices at 3535 Harbor Blvd., Suite 100, Costa Mesa, CA 92626 (“Opposer”), believes it will be damaged by the issuance of a trademark registration to OSCAR REMBAO AND SONIA REMBAO, individuals at 4168 W. Granite Dells, Tucson, AZ 85745 (“Applicants”), for the mark EL POLLO LUCKY GRILLED

CHICKEN YOU CAN BET ON & Design (Serial No. 77/950,131) in International Class 43, and hereby opposes the application.

As grounds for the opposition, Opposer alleges that:

1. On March 4, 2010, Applicant filed with the United States Patent and Trademark Office (“USPTO”), an Intent-To-Use Application, Serial Number 77/950,131, seeking to obtain, under the provisions of the Trademark Act of 1946, as amended, registration on the Principal Register of the mark EL POLLO LUCKY GRILLED CHICKEN YOU CAN BET ON & Design (“Applicant’s Mark”) for “Carry-out restaurants; fast food restaurants; restaurant; take-out restaurant services” in International Class 43.

2. Since at least as early as 1975, Opposer has been continually using the mark “EL POLLO LOCO” (“Opposer’s Mark” or “EL POLLO LOCO Mark”) and derivatives thereof in commerce on or in connection with goods and services generally described as “prepared chicken” and “restaurant services” (“Opposer’s Goods and Services”).

3. Opposer has invested substantial resources in advertising and promoting Opposer’s Goods and Services and has acquired substantial goodwill under the EL POLLO LOCO Mark.

4. As a result of Opposer’s long and extensive use of the EL POLLO LOCO Marks, Opposer’s trademarks have become distinctive.

5. Opposer will rely upon its ownership of various Federal Trademark Registrations consisting of or incorporating the mark EL POLLO LOCO, as well as the common law rights it has obtained through its long prior and continuous use of Opposer’s Mark in commerce.

6. Opposer is the owner of the mark EL POLLO LOCO (Registration No. 3,162,229) for “franchising and business consulting services relating to the establishment and/or operation of restaurants” in International Class 35. Opposer’s mark has a registration date of October 24, 2006, and the date of first use was January 1, 2000.

7. Opposer is the owner of the mark EL POLLO LOCO (Registration No. 1,237,518) for “prepared chicken with and without a batter coating for consumption on or off the premises” in International Class 29 and for “restaurant services” in International Class 42. Opposer’s mark has a registration date of May 10, 1983 and date of first use of December 6, 1980.

8. Opposer is the owner of the mark EL POLLO LOCO (Registration No. 3,262,641) for “prepared entrees consisting primarily of marinated chicken” in International Class 29 and for “prepared entrees consisting of rice and beans” in International Class 30 and for “restaurant services” in International Class 43. Opposer’s mark has a registration date of July 10, 2007 and date of first use of July 5, 2005.

9. Opposer is the owner of the mark EL POLLO LOCO (Registration No. 2,934,591) for “prepared citrus-marinated, flame-grilled chicken for consumption on or off the premises” in International Class 29 and for “restaurant services by restaurant chain known for its service of citrus-marinated, flame-grilled chicken and other Mexican dishes” in International Class 43. Opposer’s mark has a registration date of March 22, 2005 and date of first use of March 1, 2000.

10. Opposer is the owner of the mark EL POLLO LOCO FLAME-GRILLED MEXICAN CHICKEN (Registration No. 3,262,640) for “prepared entrees consisting primarily

of marinated chicken” in International Class 29 and for “prepared entrees consisting of rice and beans” in International Class 30 and for “restaurant services” in International Class 43. Opposer’s mark has a registration date of July 10, 2007 and date of first use of July 5, 2005.

11. Opposer is the owner of the mark EL POLLO LOCO FLAME-GRILLED MEXICAN CHICKEN (Registration No. 3,288,881) for “franchise services, namely, offering technical and business management assistance in the establishment and operations of restaurants” in International Class 35. Opposer’s mark has a registration date of September 4, 2007 and date of first use of July 5, 2005.



12. Opposer is the owner of the mark EL POLLO LOCO FLAME-GRILLED MEXICAN CHICKEN & Design (Registration No. 3,331,273) for “prepared entrees consisting primarily of marinated chicken” in International Class 29 and for “prepared entrees consisting of rice and beans” in International Class 30 and for “restaurant services” in International Class 43. Opposer’s mark has a registration date of November 6, 2007 and date of first use of October 13, 2005.



13. Opposer is the owner of the mark EL POLLO LOCO FLAME-GRILLED MEXICAN CHICKEN & Design (Registration No. 3,345,387) for

“prepared entrees consisting primarily of marinated chicken” in International Class 29 and for “prepared entrees consisting of rice and pinto beans” in International Class 30 and for “restaurant services” in International Class 43. Opposer’s mark has a registration date of November 27, 2007 and date of first use of October 13, 2005.



14. Opposer is the owner of the mark **EL POLLO LOCO** **FLAME-GRILLED MEXICAN CHICKEN & Design** (Registration No. 3,320,540) for “franchise services, namely, offering technical and business management assistance in the establishment and operation of restaurants” in International Class 35. Opposer’s mark has a registration date of October 23, 2007 and date of first use of October 13, 2005. The foregoing listing of Opposer’s Trademark Registrations are referred to hereinafter collectively as “Opposer’s Marks” or the “EL POLLO LOCO Marks”.

15. Opposer's registrations are not limited by channels of trade or classes of purchasers.

16. Opposer's Registration Nos. 3,162,229, 1,237,518, 3,262,641, 2,934,591, 3,262,640, 3,288,881, 3,331,273, 3,345,387, and 3,320,540 are valid and subsisting and Registration No. 1,237,518 is incontestable pursuant to 15 U.S.C. § 1065. Each registration is conclusive evidence of the validity of each registered mark set forth therein, the registration of each registered mark set forth therein, Opposer's ownership of each registered mark, and

Opposer's exclusive right to use each registered mark in connection with the Goods and Services recited in the registrations.

17. Opposer has, prior to the filing date of Applicant's intent-to-use based application, sold and continues to sell in commerce in the United States its goods and services using Opposer's Marks.

18. Opposer has extensively used, advertised, promoted, offered, and sold Opposer's Goods and Services to the public through various channels of trade. Opposer's customers and the public in general know and recognize Opposer's EL POLLO LOCO marks and associate same with Opposer and/or Opposer's Goods and Services. As a result of its long and prior use of the EL POLLO LOCO Marks, Opposer has earned extensive goodwill in connection with the sale of Goods and Services bearing Opposer's Marks.

**FIRST GROUND FOR OPPOSITION
(LIKELIHOOD OF CONFUSION - FEDERAL)**

19. Opposer re-alleges the allegations contained in Paragraphs 1 through 18_ of this Notice of Opposition.

20. Applicant's EL POLLO LUCKY GRILLED CHICKEN YOU CAN BET ON & Design Mark so resembles Opposer's EL POLLO LOCO and EL POLLO LOCO FLAME-GRILLED MEXICAN CHICKEN Marks in sound, appearance and commercial impression as to be likely, when used in connection with Applicant's Services, to cause confusion or mistake or to deceive purchasers resulting in damage and detriment to Opposer and its reputation.

21. Applicant's constructive date of first use, the filing date of March 4, 2010, as claimed in Application Serial No.77/950,131, is subsequent to Opposer's date of first use of any of Opposer's Marks. As such, priority is not an issue in this proceeding.

22. Opposer's Goods and Services and Applicant's Services are related and overlapping, will be offered and sold through the same channels of trade, and purchased and consumed by the same class of purchasers.

23. Opposer's customers, and the public in general, are likely to be confused, mistaken or deceived as to the origin, affiliation, endorsement and sponsorship of Applicant's Services offered and marketed under Applicant's Mark and misled into believing that such Services are offered by, emanate from, or are in some way associated with, sponsored by or endorsed by Opposer, to the damage and detriment of Opposer and its reputation.

24. Opposer will be damaged by Applicant's registration of the EL POLLO LUCKY GRILLED CHICKEN YOU CAN BET ON & Design Mark as set forth in Application Serial No.77/950,131, in that the mark is confusingly similar in appearance, sound and commercial impression to Opposer's distinctive EL POLLO LOCO Marks and is being used in connection with identical Services and related to and overlapping Opposer's Goods and Services.

25. Applicant's registration of the Applicant's Mark would be contrary to 15 U.S.C. § 1052(d) and would violate and diminish the prior and superior rights of Opposer to its EL POLLO LOCO Marks.

26. Because Applicant's Mark is similar to Opposer's Mark in the same International Class 43, Applicant's Mark is likely to cause confusion, mistake, or deception

amongst the general and consuming public as to whether Applicant's goods are being offered by, or in affiliation with, Opposer causing damage to Opposer.

**SECOND GROUND FOR OPPOSITION
(LIKELIHOOD OF CONFUSION - COMMON LAW)**

27. Opposer re-alleges the allegations contained in Paragraphs 1 through 26 of this Notice of Opposition.

28. In addition to Opposer's use of the EL POLLO LOCO Marks as recited in the foregoing Registrations, Opposer has broadly continually used the EL POLLO LOCO Marks for prepared chicken" and "restaurant services", at least as early as 1975.

29. Applicant's EL POLLO LUCKY GRILLED CHICKEN YOU CAN BET ON & Design Mark so resembles Opposer's EL POLLO LOCO Marks as to be likely, when used on or in connection with Applicant's Services, to cause confusion or mistake or to deceive purchasers resulting in damage and detriment to Opposer and its reputation.

30. The first date upon which Applicant ultimately uses its EL POLLO LUCKY GRILLED CHICKEN YOU CAN BET ON & Design Mark in commerce on any of the goods recited in Intent-to-Use Application Serial No. 77/950,131, shall be subsequent to Opposer's date of first use of any of the EL POLLO LOCO Marks, 1975. As such, priority is not an issue in this proceeding.

~~31. Opposer's Goods and Services and Applicant's Services are related and overlapping, will or are likely to be offered through the same channels of trade, and purchased and consumed by the same class of purchasers.~~

32. Opposer's customers, and the public in general, are likely to be confused, mistaken or deceived as to the origin, affiliation, endorsement or sponsorship of Applicant's

Services offered under Applicant's Mark and misled into believing that such Services are offered by, emanate from, or are in some way associated with Opposer, to the damage and detriment of Opposer and its reputation.

33. Opposer will be damaged by Applicant's registration of the mark EL POLLO LUCKY GRILLED CHICKEN YOU CAN BET ON & Design as set forth in Application Serial No. 77/950,131 as it is confusingly similar in sound, appearance and commercial impression to Opposer's distinctive EL POLLO LOCO Marks, thereby violating Opposer's common law rights to its Marks.

WHEREFORE, Opposer requests that registration of the mark EL POLLO LUCKY GRILLED CHICKEN YOU CAN BET ON (Serial No. 77/950,131) be denied to Applicant and this opposition be sustained.

Respectfully submitted,



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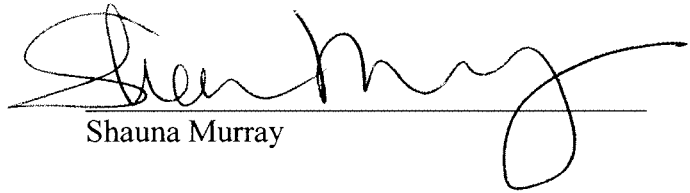
*Attorneys for Opposer
El Pollo Loco, Inc.*

DATE: December 17, 2010

CERTIFICATE OF SERVICE

I, Shauna Murray, hereby certify that on December 17, 2010, a true and correct copy of the foregoing Notice of Opposition was served via electronic mail and U.S. First Class Mail, postage prepaid, upon the following:

Oscar and Sonia Rembao
4168 W. Granite Dells
Tucson, AZ 85745
Email: pollofeliz@live.com
Applicant



Shauna Murray